REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed May 21, 2007 (Paper No. 20070507). Upon entry of this response, claims 1-31, 58 and 59 are pending in the application. Claims 1, 4, 10, 13-14, 19-24 and 28-29 have been amended and claims 58 and 59 have been added. Applicants respectfully request reconsideration and allowance of all pending claims.

I.   Claim Rejections under 35 U.S.C. §102(e)

A.   Statement of Rejection

Claims 1, 4-17, 19-25, 27, 29, and 30 have been rejected under 35 U.S.C. § 102(e) as allegedly anticipated by *Hassell et al.* ("*Hassell*," U.S. Pat. App. Pub. No. 2004/0128685). Applicants respectfully traverse this rejection as applied to pending claims 1, 4-17, 19-25, 27, 29, and 30.

B.   Discussion of Rejections

It is axiomatic that "[a]nticipation requires the disclosure in a single prior art reference of each element of the claim under consideration." *W. L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1554, 220 USPQ 303, 313 (Fed. Cir. 1983). Therefore, every claimed feature of the claimed invention must be represented in the applied reference to constitute a proper rejection under 35 U.S.C. § 102(e).

In the present case, not every feature of the amended claims is represented in the *Hassell* reference.

1.   Independent Claim 1

Applicants' amended claim 1 provides as follows (emphasis added):

> A recordable media content archiving system in a subscriber network, said recordable media content archiving system comprising:
> a memory for storing recordable media content characterizing information;
> a storage device capable of storing on a plurality of portable storage medium, wherein each portable storage medium is one of a plurality of different portable storage medium types; and
> a processor configured with the memory to:
> receive into the memory the characterizing information corresponding to respective recordable media content;
> provide a user interface with at least a portion of the received characterizing information, said portion corresponding to a first recordable media content;
> download the first recordable media content via the subscriber network from a server responsive to a first user input selecting an identifier of the first recordable media content from the user interface;
> ***select without user intervention a portable storage medium type from the plurality of portable storage medium types, the selected portable storage medium type corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content***, and
> store on at least one of the plurality of portable storage mediums of the plurality of different portable storage medium types the downloaded first recordable media content, the at least one of the plurality of portable storage mediums corresponding to the category of the first recordable media content.

Applicants respectfully request that the rejection of independent claim 1 be withdrawn for at least the reason that *Hassell* fails to disclose, teach, or suggest at least the features recited and emphasized above in claim 1.

The Office Action alleges that "Hassell et al. discloses a program guide that allows a user to transfer programs and super-programs stored on digital storage drive 49 to other volumes of digital storage device 49 or to secondary storage device 47 (p.8, paragraphs 81-88)." (Office Action, page 4). *Hassell* teaches that:

> ***The program guide may also allow the user to transfer programs and super-programs stored on digital storage device 49 to other volumes of digital storage device 49 or to secondary storage device 47*** (FIG. 3.). ... This feature may be accessed by, for example, issuing appropriate commands with user interface 46. ...

The program guide responds to this indication by issuing appropriate instructions to digital storage device 49 to read the selected programs and associated data or the programs and associated data of the selected super-program sequence. The program guide then transfers the programs and associated data (if possible) in an appropriate format to secondary program data storage device 47. ... The program guide may also transfer the programs and data to another volume of digital storage device 49.

If digital storage device 49 is a device that uses removable recording media (e.g., floppy disks or recordable optical discs) *the program guide may also allow a user to view a global media library screen which indicates directory information of removable storage media* used with the program guide. ...

The *global media library may be maintained automatically by the program guide*. For example, the program guide may store or update directory entry information according to the current viewer preferences (described below) in a central storage area (e.g., random access memory (RAM) or a central hard disk drive) each time directory information is stored or updated on a removable storage medium. The program-guide may also store unique identifiers identifying the removable storage medium on which programs are stored (e.g., volume names or media numbers).

(Page 8, paragraphs 81-86, emphasis added). Even assuming, *arguendo*, that *Hassell* discloses the program guide automatically maintains directory information of the recording media, *Hassell* does not teach the program guide selecting the transfer locations. Thus, *Hassell* does not teach or suggest a processor configured to "*select without user intervention a portable storage medium type from the plurality of portable storage medium types ... for storing the downloaded first recordable media content*" as recited in claim 1.

Additionally, the Office Action alleges "Hassell et al. further discloses that if the user indicates a desire to access a feature of the program guide, which operates on a medium that is not currently loaded in digital storage device 49, the program guide may automatically change the loaded storage medium if digital storage device 49 has the ability to do so. Digital storage device 49 ... can re-arrange the discs until the correct disc is positioned for writing (p.8, paragraph 89)." (Office Action, page 4). *Hassell* teaches that:

If the user indicates a desire to access a feature of the program guide which operates on a medium that is not currently loaded in digital storage device 49, the program guide may automatically change the loaded

storage medium if digital storage device 49 has the ability to do so. Digital storage device 49 may be, for example, an optical jukebox with multiple recordable optical discs. **If the user selects a program on a disc** not currently positioned before a read/write head of the jukebox, the jukebox re-arranges the discs until **the disc with the selected program** is positioned for reading or writing. If **the disc with the selected program** is not in the jukebox, the program guide may display indication 255 to the user that the disc must be loaded. The program guide may also display such an indication if, for example, digital storage device 49 is a floppy disk drive and the disk with the selected program is not in the drive.

(Page 8, paragraphs 89, emphasis added). Even assuming, *arguendo*, that *Hassell* teaches accessing a disc based upon the user's selection of a program, the program content in *Hassell* has already been stored to the disc in contrast to the Applicants' selecting feature. That is, the selection is for the future storing in the portable storage medium of content that has been downloaded, as is evident from the explicit claim language. Thus, even assuming arguendo *Hassell* teaches the program guide **changing a disc to access a stored program**, that is not the same as a processor configured to "**select … a portable storage medium type … for storing the downloaded first recordable media content**" as recited in claim 1.

Additionally, even assuming, *arguendo*, that *Hassell* teaches the program guide selecting the disc, *Hassell* does not teach a processor configured to "**select without user intervention a portable storage medium type … corresponding to a category of the first recordable media content**," as recited in claim 1. Rather, the disc change in *Hassell* appears to be **based upon the presence of a _user selected_ program**.

The Office Action alleges "even if the user chooses a program and particular medium for recording, it is the program guide that implements the selecting and storing functions. Therefore, the examiner interprets the program guide as selecting the medium for storage without user intervention. This also meets the limitation of selecting 'without user intervention, a portable storage medium type corresponding to a media type of the first recordable media content, from the plurality of different portable storage medium types for storing the downloaded

first recordable media content' as currently claimed." (Office Action, pages 4-5). However,

Hassell teaches that:

> ***Making a selection for digital recording causes the program guide to gather information from the currently loaded digital storage medium.*** Such information may include the estimated amount of time remaining on the storage medium (if, for example, the digital storage medium is a partially full disk). The program guide may also check directory information on the digital storage medium and compare it to the selected program listing to determine if the selected program has already been recorded. If the program guide determines that the selection has already been recorded, re-recording is not necessary. ...

> In response to an indication by the user to digitally record a selection, the programming guide may generate a recording schedule screen for display on monitor 45. ... Recording schedule screen 80 contains a number of pieces of information which may include, for example, the volume name of the currently loaded medium, an estimate of the amount of time remaining on the medium, and a grid 81 or other suitable list or table listing the programs currently scheduled for recording and relevant recording information. ...

> The user can access the associated program data supplied by main facility 12 of FIG. 1 of the programs scheduled to be recorded by indicating a desire to do so ... In response to such an indication, the program guide generates a selected program listing information screen ... similar to a program listing information screen (see FIG. 6), but may also contain user fields that the user may edit to add information that the user desires to associate with the program. ...

> ...

> ***Before recording a new program and associated program data, the program guide may automatically cause digital storage device 49 to search for available space***, and may store the program and associated program data anywhere on digital storage device 49 (e.g., between two other programs). The program and associated program data may even be stored in non-contiguous space on the storage medium. A best-fit algorithm may be used to determine where to store the program based on available free space and the length and format of the program.

(Page 4, paragraphs 43-45 and page 5, paragraph 51). Even assuming, *arguendo*, that *Hassell*

discloses the program guide automatically searching the digital storage device before recording

and maintaining directory information, as noted above, *Hassell* does not teach the program

guide selecting the digital storage device. Thus, *Hassell* does not teach or suggest a processor

configured to "***select without user intervention a portable storage medium type from the***

plurality of portable storage medium types ... for storing the downloaded first recordable

media content" as recited in claim 1.

Further, even assuming, *arguendo*, that *Hassell* teaches a processor selecting a storage

medium type, *Hassell* does not disclose or suggest "***select without user intervention a***

portable storage medium type ... corresponding to <u>a category</u> of the first recordable

media content." *Hassell* does not disclose a portable storage medium type corresponding to a

category. Nor does *Hassell* teach or suggest selecting a portable storage medium type based

upon a category. Therefore, *Hassell* does not teach or suggest a processor configured to

"***select without user intervention a portable storage medium type from the plurality of***

portable storage medium types, the selected portable storage medium type

corresponding to a category of the first recordable media content, for storing the

downloaded first recordable media content" as recited in claim 1.

For at least the reasons described above, *Hassell* fails to disclose, teach or suggest all

of the features recited in claim 1. Therefore, Applicants respectfully submit that the rejection of

claim 1 be withdrawn.

2. Claims 4-17, 19-25, 27, 29, and 30

Because claim 1 is allowable over *Hassell*, dependent claims 4-17, 19-25, 27, 29, and 30

are allowable as a matter of law for at least the reason that at each depends from an allowable

claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Therefore,

Applicants respectfully request that the rejection of claims 4-17, 19-25, 27, 29, and 30 be

withdrawn.

II. Claim Rejections under 35 U.S.C. §103(a)

A. Statement of Rejection

Claims 2, 18 and 26 have been rejected under 35 U.S.C. § 103(a) as allegedly

unpatentable over *Hassell* in view of *LaJoie et al.* ("*LaJoie,*" U.S. Pat. No. 5,850,218). Claim 3 has

been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *LaJoie* and in further view of *Lewis* ("*Lewis*," U.S. Pat. App. Pub. No. *2003/0040962*). Claim 28 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Browne, et al.* ("*Browne*," International Publication No. WO 92/22983). Claim 31 has been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over *Hassell* in view of *Russo* ("*Russo*," U.S. Pat. No. 5,619,247). Applicants respectfully traverse these rejections.

B. Discussion of Rejections

The U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a *prima facie* case of obviousness according to the factual inquiries expressed in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966). The four factual inquires, also expressed in MPEP 2100-116, are as follows:

(A)   Determining the scope and contents of the prior art;

(B)   Ascertaining the differences between the prior art and the claims in issue;

(C)   Resolving the level of ordinary skill in the pertinent art; and

(D)   Evaluating evidence of secondary considerations.

Applicants respectfully submit that a *prima facie* case of obviousness is not established using the art of record.

1. Claims 2, 18 and 26

As described above, Applicants respectfully submit that *Hassell* fails to disclose, teach, or suggest at least the features of a processor configured to "***select without user intervention a portable storage medium type from the plurality of portable storage medium types, the selected portable storage medium type corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content***" as recited in claim 1. The addition of *LaJoie* fails to remedy these deficiencies. Since dependent

claims 2, 18 and 26 incorporate these same features found in independent claim 1, Applicants

respectfully submit that claims 2, 18 and 26 are allowable over *Hassell* in view of *LaJoie*.

2. Claim 3

As described above, Applicants respectfully submit that *Hassell* in view of *LaJoie* fails to

disclose, teach, or suggest at least the features of a processor configured to "***select without user***

intervention a portable storage medium type from the plurality of portable storage

medium types, the selected portable storage medium type corresponding to a category

of the first recordable media content, for storing the downloaded first recordable media

content" as recited in claim 1. The addition of *Lewis* fails to remedy these deficiencies. Since

dependent claim 3 incorporates these same features found in independent claim 1, Applicants

respectfully submit that claim 3 is allowable over *Hassell* in view of *LaJoie* and in further view of

Lewis.

3. Claim 28

As described above, Applicants respectfully submit that *Hassell* fails to disclose, teach, or

suggest at least the features of a processor configured to "***select without user intervention a***

portable storage medium type from the plurality of portable storage medium types, the

selected portable storage medium type corresponding to a category of the first

recordable media content, for storing the downloaded first recordable media content" as

recited in claim 1. The addition of *Browne* fails to remedy these deficiencies. Since dependent

claim 28 incorporates these same features found in independent claim 1, Applicants respectfully

submit that claim 28 is allowable over *Hassell* in view of *Browne*.

Moreover, Applicants respectfully submit that *Hassell* in view of *Browne* fails to teach,

disclose, or suggest "***authorized access locks have corresponding icons displayed on one***

of a plurality of screen displays to alert the user to a requirement for authorized access"

as recited in claim 28. The Office Action acknowledges that "Hassell et al. does not disclose

that the authorized access locks have corresponding icons displayed on one of a plurality of

screen displays to alert the user to a requirement for authorized access." (Office Action, page

12).

The Office Action alleges that "Browne et al. discloses the use of icons to alert the user

of access locks (Fig. 6)." (Office Action, page 12). However *Browne* teaches, in reference to

FIG. 6, that:

> When the stored program list 600 is displayed, *the user may lock certain of the listed stored programs. Locking a program involves selecting a program from the list and marking it as locked. A locked program will not be erased* regardless of the program storage mode selected in the program storage option 301 selected in setup page 300, shown in Fig. 3. ...
>
> *The user can also set a filter on the stored program list, for example, to restrict the list of programs output on the stored program list* 600 to those of interest to a single viewer. If there are two users of the multi-source recorder player 100, it is possible for each to view only his or her own listings and not those of the other person. *This can be preformed by incorporating a user password.* ...
>
> *The multi-source recorder player 100*, when operated as a multi-user device, *will ask the user his or her password before making any menus or screens available. Once the password is received the multi-source recorder player 100 will interface with the user in the same way as described above*, ...

(Pages 25-26). *Browne* does not teach use of icons to alert the user of access locks, but rather

entering a password before displaying restricted programs. *Browne* also appears to disclose

using icons to prevent erasing programs. Therefore, *Browne* fails to teach or suggest

"*authorized access locks have corresponding icons displayed on one of a plurality of*

screen displays to alert the user to a requirement for authorized access" as recited in

claim 28.

For at least the reasons described above, *Hassell* in view of *Browne* fails to disclose,

teach or suggest all of the features recited in claim 28. Therefore, Applicants respectfully

submit that the rejection of claim 28 be withdrawn.

4.   Claim 31

As described above, Applicants respectfully submit that *Hassell* fails to disclose, teach, or suggest at least the features of a processor configured to "***select without user intervention a portable storage medium type from the plurality of portable storage medium types, the selected portable storage medium type corresponding to a category of the first recordable media content, for storing the downloaded first recordable media content***" as recited in claim 1. The addition of *Russo* fails to remedy these deficiencies. Since dependent claim 31 incorporates these same features found in independent claim 1, Applicants respectfully submit that claim 31 is allowable over *Hassell* in view of *Russo*.

III.   New Claims

Claims 58 and 59 have been added into the application through this Response. Claims 58 and 59 are allowable over the cited references for at least the reason that each depends from an allowable claim. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988). Applicants, therefore, respectfully request that these claims be held to be allowable.

CONCLUSION

Applicants respectfully request that all outstanding objections and rejections be withdrawn and that this application and presently pending claims 1-31, 58, and 59 be allowed to issue. Any statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. Furthermore, any and all findings of well-known art and official notice, or statements interpreted similarly, should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support such conclusions. If the Examiner has any questions or comments regarding Applicants' response, the Examiner is encouraged to telephone Applicants' undersigned counsel.

Respectfully submitted,

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